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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

HODES 3-10-15-19-13-6

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on April 21, 2009

Signature /Elizabeth Schumacher/

Typed or printed name Elizabeth Schumacher

Application Number

10/674,448

Filed

September 30, 2003

First Named Inventor

Marc Scott Hodes

Art Unit

1797

Examiner

Jyoti Nagpaul

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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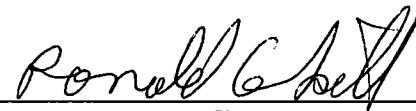
☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 47,500

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Ronald J. Corbett

Typed or printed name

972-480-8800

Telephone number

April 21, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Marc S. Hodes, *et al.*

Serial No.: 10/674,448

Filed: September 30, 2003

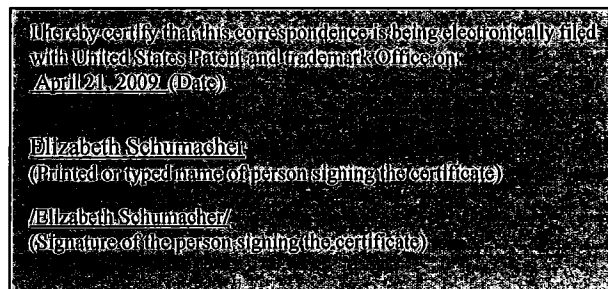
Title: METHOD AND APPARATUS FOR CONTROLLING THE FLOW
RESISTANCE OF A FLUID ON NANOSTRUCTURED OR
MICROSTRUCTURED SURFACES

Grp./A.U.: 1743

Examiner: Jyoti Nagpaul

Confirmation No.: 4121

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450



Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Appellants have carefully considered this application in connection with the Examiner's Reopening of prosecution and new grounds of rejection mailed January 28, 2009, and respectfully request a Reinstatement of the Appeal and a pre-appeal brief review of this application in view of the following arguments.

ARGUMENTS

Claims 1-6 and 12-13 are currently pending in the application. This is the second reinstatement of the Appeal. Some of the new grounds for rejecting or objecting to the claims could have been raised in any number of several previous office actions filed in this case. It is disappointing to see such grounds raised at such an advanced stage of prosecution.

I. Claim Objection

The Examiner, for the first time, objects to the use of the terms "first fluid" and "selected liquid" in Claims 1 and 5 on the grounds that, "It appears that applicants intend to claim the same fluid." (Detailed Action, Page 2, last line). The Examiner requests correction.

In response, the Appellants note that contrary to the Examiner's assertion, they did not intend the fluid and liquid recited in Claims 1 and 5 to refer to the same material. Nor is it apparent to the Appellants why one of ordinary skill in the art, after reading the specification, would come to this conclusion. For instance, the specification states:

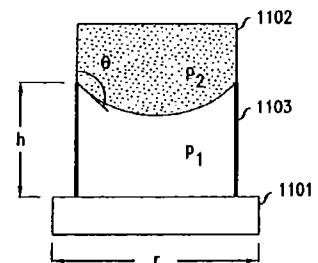
the term closed cell is defined as a cell that is enclosed on all sides except for the side upon which a liquid is or could be disposed. (emphasis added, Page 8, Lines 11-13)

the term fluid is intended to encompass both gases (such as, illustratively, air) and liquids that could be disposed within the cells of the feature pattern (emphasis added, Page 8, Lines 29-31)

by changing the pressure within the individual cells, such as cell 701, the liquid droplet 801 can be either drawn into the cells or, alternatively, repelled out of the cell (Page 8, Lines 31-33)

FIG. 11B

FIG. 11B depicts an example fluid (air) having pressure P_1 within an example feature pattern 1103, and, an example liquid 1102 (water) having pressure P_2 disposed on the feature pattern 1103. Based on such disclosure, the Appellants maintain that one of ordinary skill in the art would not confuse the liquid and fluid recited in Claims 1 and 5 as being the same thing. Therefore, there is no reason to correct Claims 1 and 5, along the lines suggested by the Examiner.



II. Rejection of Claims 1-6 under 35 U.S.C. §102

The Examiner has now rejected Claims 1-6 under 35 U.S.C. §102(b) as being anticipated by U.S. 4,750,693 to Lobert et al. ("Lobert").

Referring to Claim 1, the Examiner also states, for the first time:

Lines 5-7 appear to be more appropriately drawn to a method step not germane to patentability

in apparatus Claim 1. It does not appear that the "means for changing the pressure" structurally forms any part of the apparatus itself." (Detailed Action, Page 4, Lines 5-8).

In response, the Examiner's attention is drawn to 35 U.S.C. § 112, paragraph six:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (emphasis added)

Therefore the Examiner is required under 35 U.S.C. § 112 to construe the "means for changing the pressure," as recited in Claim 1 or 5 as covering the corresponding structure and equivalents thereof. The Examiner however has not shown that the relied upon art teaches such a structure of an equivalent thereof.

Concerning the rejection of the claims in view of Lobert, the Appellants submit that the Examiner has not established grounds for Lobert to teach each and every element of Claims 1 or 5.

The Examiner asserts that Lobert's grooves 10 teach a plurality of closed cells as recited in Claims 1 and 5 (Detailed Action, Page 3, Lines 16-17).

As indicated above, a closed cell is defined as a cell that is enclosed on all sides except for the side upon which a liquid is or could be disposed (Detailed description, Page 8, Lines 11-13). The Examiner has not presented evidence, however, showing that Lobert's grooves form closed cells. Rather, Lobert's figures (FIG. 1-6) show cross-sections of flat walls with a cylindrical or saw-tooth shaped recess, with no indication that the recess is enclosed (e.g., on ends going into or out of the page showing the cross-sections) to form a closed cell, as defined in the present application.

The Examiner also asserts that Lobert's device inherently teaches, "changing the pressure of at least a first fluid disposed within said plurality of closed cells in order to cause a selected liquid to change the degree of penetration of said feature pattern," as recited in Claims 1 and 5, because:

it is inherent in Lobert's invention that a particular and chosen movement and direction of a moving body and taking into consideration appropriately selected parameters such as flow velocity, flow direction, drag factor, etc., that one can inherently can[sic] change the pressure of a first fluid disposed within the plurality of closed cells (10) in order to cause a selected liquid to change the degree of penetration of the feature pattern. (emphasis added, Detailed Action, Page 3, Line 20-Page 4, Line 2).

The Appellants submit that the Examiner has not provided a basis in fact and/or technical reasoning to reasonably support the determination that it necessarily flows from some, "particular and chosen movement and direction" taught by Lobert, that would cause a change the pressure of a fluid in a closed cell that changes the degree of penetration of a liquid, such as recited in Claims 1 or 5. For instance, the Examiner does not cite any evidence in Lobert that show a particular movement and direction of Lobert's device that actually causes temperature or pressure changes in a fluid disposed in the grooves, that the Examiner asserts to be closed cells, that changes the degree of

penetration of some overlying liquid. Nor has the Examiner presented reasoning that such changes necessarily flow from Lobert. For instance, the Examiner has not presented any evidence that Lobert even considers a configuration of his airborne or waterborne device where a fluid is disposed within a groove, and a liquid changes its degree of penetration into the groove, as a function of "a particular and chosen movement and direction." Therefore, the Examiner's statements do not have rational or evidentiary underpinning to support the asserted teaching by Lobert. The Appellants do not waive their right to evidence to support a feature claimed by the Examiner as being inherent in the prior art, and the Examiner does not furnish any such evidentiary support from such a claimed inherency.

Therefore, the Appellants respectfully request the Examiner to withdraw the §102 rejection with respect to Claim 1 and its dependent claims, and, to Claim 5.

III. Rejection of Claims 12-13 under 35 U.S.C. §103

The Examiner has rejected Claims 12-13 under 35 U.S.C. §103(a) as being unpatentable over Lobert. The Appellants respectfully disagree because, for the reasons presented in Section II, the Examiner has not shown how Lobert teaches or suggest all of the elements of Claim 1, which Claims 12-13 are dependent on.

In view of the foregoing remarks, the cited references as applied by the Examiner do not establish a *prima facie* case of obviousness to support the Examiner's rejection of the above claim under 35 U.S.C. §103(a). The Appellants therefore respectfully request the Examiner withdraw the rejection.

IV. Conclusion

In view of the foregoing arguments, the Appellants see all of the Claims currently pending in this application to be in condition for allowance and respectfully request the Examiner to withdraw these rejections, and issue a timely Notice of Allowance for these claims.

The Appellants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,
HITT GAINES, P.C.



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Dated: April 21, 2009
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